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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,260	11/15/1999	ARTHUR JOST	GEN-067	2733

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GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM, PA 19044

EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/440,260

Applicant(s)

JOST ET AL.

Examiner

Andrew Y. Koenig

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 27 July 2006 have been fully considered but they are not persuasive.

The applicant notes that claim 6 was previously cancelled so the rejection of claim 6 is improper, and thus request the issuance of a new Office Action correcting this error and restarting of the time period for reply. The examiner disagrees; since claim 6 was previously cancelled, the rejection for claim 6 is moot, but does not change any of the grounds of rejection. The examiner appreciates the applicant's notice of this formality.

The applicant argues the motivation provided of "the benefit of having the initiation process executed by the set top terminal in order to enable device to be added without supervision thereby reducing the overall support costs of the problem" is not a problem associated with Caporizzo and thus has not answered "why would one of ordinary skill in the art modify the bit error rate teaching of Caporizzo with the teachings of Corrigan. The examiner disagrees; in that even though Caporizzo may not recognize the problem, it does not preclude one of ordinary skill in the art to modify the teachings of Caporizzo. In this case, Corrigan teaches the drawbacks of typical cable systems such as "existing cable television systems have the drawback of typically requiring an operator to configure the cable television set-top box at the customer location. In existing cable television systems, security and authentication information is typically entered at the manufacturing facility or the customer location. Initialization of the cable television set top box requires the operator to enter information at the subscriber location" (see Corrigan: col. 1, ll. 28-35). Corrigan provides a solution wherein the set top box is able to register by receiving operational parameters received from the headend (col. 7, ll. 5-16). From the teachings of Corrigan, one of ordinary skill in the art would readily see the benefit of having a system register without the supervision of an installer. Corrigan recognizes the problem of typical cable system management and benefits of remote management.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation is drawn from the secondary reference of Corrigan.

Further, the applicant argues that combination of Caporizzo and Corrigan does not work and destroys the purpose of Caporizzo. The examiner disagrees; Caporizzo teaches that a system wide check may be simultaneously initiated on all set top terminals (col. 5, ll. 9-22), wherein every terminal is able to determine bit error information, which does not destroy the teachings of an unregistered set top terminal as any set top terminal is able to gather error information. Further, Caporizzo does not explicitly teach that a settop terminal that is not yet registered cannot receive and process messages to know what the bit error rate information is as posed by the applicant, thus Caporizzo does not teach away from the combination as set forth by the examiner. The applicant further poses the question that "if the settop terminal is already receiving and processing data, why does it need to register now?" The examiner notes that Corrigan teaches the benefits of remote management, thereby motivating one of ordinary skill in the art to register devices.

In response to applicant's argument that combination of Caporizzo and Corrigan does not work and destroys the purpose of Caporizzo, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The applicant argues that the examiner assert that bit error information is the same as a "registration request message." The examiner disagrees; the question is whether a response to bit error rate can read on the broader registration message. The question becomes a matter of defining the scope of a registration message. Since there is no explicit or special definition provided by the applicant, it appears that it is any message used to register a device. As a result, a response with bit error rate information can be used to register a device, as it provides information on the location of the device, which is the broadest reasonable interpretation and is consistent with the applicant's specification. Whereas the examiner recognizes that a "bit error rate" is not identical to a "registration" message, the "bit error rate" of Caporizzo can be construed as a registration message.

The applicant argues that the examiner fails to address the fact that bit error information is channel specific, thus requiring the system to "register" for each channel. The examiner disagrees; as stated above, the scope of "registration" message is discussed above. As a result, the examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The applicant argues that the since a settop terminal is typically registered only once in a great while, the bit error rate would therefore only be reported once in a lifetime or every couple of years for terminals. The examiner disagrees; as the scope of registration is given the broadest reasonable interpretation in the art as discussed above.

With respect to claim 25, the applicant argues that calculations and reporting done by Caporizzo occurs regardless of the "benefit of saving money" as provided by the examiner, and that there is no motivation to add Henderson to the combination of Caporizzo and Corrigan. The examiner disagrees; in response to applicant's argument that there is no suggestion to combine the references, the

examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation is derived from the knowledge generally available to one of ordinary skill in the art.

A handwritten signature in black ink, appearing to read "John Miller", with a stylized, looping flourish extending to the right.

JOHN MILLER
SUPERVISORY PATENT EXAMINER
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